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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/176,274	10/21/1998	HIDEAKI OHSHIMA	862.2492	7987

5514 7590 01/22/2003

FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2672

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/176,274

Applicant(s)

OHSHIMA ET AL. 

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 12/10/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/176,274 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. The after final amendment filed on 09/10/02 has been entered. Claims 30-40 have been cancelled.

Response to Arguments

3. Applicant's arguments filed 09/10/02 have been fully considered but they are not persuasive.

The restriction requirement is maintained since claims 12-14 and 26-28 correspond to a different invention than claims 1-11, 15-25, and 29. Claims 12-14 and 26-28 claim an invention that deals with objects, editing objects, and determining a new rendering attribute for each object of the object set in accordance with a change in size for the set. Originally examined claims 1-11, 15-25, and 29 claimed holding output images, selecting output images, generating output images, determining a rendering position of the output image, and rendering the output image. The first embodiment described at pages 12-26 and figures 2-7 corresponds to claims 12-14 and 26-28 and the second embodiment described at pages 27-42 and figures 8-17C corresponds to claims 1-11, 15-25, and 29. The first embodiment describes changing the size of the object set, see figure 4 corresponding portion of specification and how objects are

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defined, see figure 5 and corresponding portion of specification. The second embodiment describes selecting images, frames, and inputting text. The second embodiment does describe frame objects (page 29 lines 3, 5, 9, and 10; page 34 lines 19, 21, and 23; page 36 line 9; and page 40 line 22 to page 41 line 2—"according to the present invention, a character box, a frame that bounds a figure or image, or a grouped figure is handled as an object set") but the second embodiment is actually directed to handling images that will be within the frame or handling characters that will be within the character box. Thus, non-elected claims 12-14 and 26-28 correspond to one invention while examined claims 1-11, 15-25, and 29 correspond to another invention. The search for the claims 1-11, 15-25, and 29 would not be the same as the search required for claims 12-14 and 26-28. Processing of images is recognized as being different from processing objects that may be rendered into images of the objects.

The arguments for the selection means made reference to page 14 lines 18-26 and page 15 lines 1-15. This part of the specification selects a frame which earlier was described as a frame object and it describes selecting the frame by interacting with frame information, image information, document information and the like, however, it does not describe selecting image information. The arguments for the generation means and the determination means made reference to page 15 lines 16-26 and page 16 lines 1-7. This part of the specification describes objects and does not describe the claimed image. The arguments for the rendering means made reference to page 16 lines 8-17. This part of the specification describes rendering objects and not the claimed image. Rendering objects converts a high level description of an object into a

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low level description on a pixel basis of the image to be displayed. Thus, these parts of claim 1 do not find support in the description of the first embodiment. Therefore, the argument that the language added to claim 1 finds support by figure 4 and its accompanying description is not persuasive since the preceding portion of the claim finds support in the second embodiment illustrated in figures 8-17C. Thus the 112 first paragraph rejection is maintained.

Election/Restrictions

4. This application contains claims 12-14 and 26-28 drawn to an invention nonelected with traverse in Paper No. 8, mail room receipt date of 10/15/2001. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11, 15-25 and 29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The 09/10/02

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amendment amended claims 1, 15, and 29. Independent claim 1 was amended by adding:

wherein said output image is comprised of more than one object, each object having a rendering attribute, and wherein said rendering means renders the output image on the basis of the rendering attributes of the objects comprising the output image.

Independent claims 15 and 29 were amended by adding:

wherein said output image is comprised of more than one object, each object having a rendering attribute, and wherein said rendering step renders the output image on the basis of the rendering attributes of the objects comprising the output image.

Independent claims 1, 15 and 29 prior to the amendment only claimed output images and output image. Prior to this amendment the independent claims were directed to the invention illustrated in figures 8-10. The limitations added to the independent claims are from the invention illustrated in figures 2-5. The originally filed specification did not describe the combination now claimed.

7. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

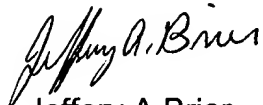
(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Jeffery A Brier
Primary Examiner
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